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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,335	08/15/2003	Edwin C. Bailey	14518.(new)	1938
26712	7590	02/10/2005	EXAMINER	
HODGSON RUSS LLP ONE M & T PLAZA SUITE 2000 BUFFALO, NY 14203-2391			RODRIGUEZ, JOSEPH C	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/642,335

**Applicant(s)**

BAILEY, EDWIN

**Examiner**

Joseph C Rodriguez

**Art Unit**

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/21/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Specification***

***Claim Objections***

In claim 1, line 8, the language "at least 200,000" should read "at least 200,000 psi".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 are rejected under 35 U.S.C. 102(e) as anticipated by Adams et al. ("Adams I")(US 6,152,307) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Van den Syte et al. ("Syte")(US 4,042,423) and Adams et al. ("Adams II")(US 6,186,337).

Regarding claims 1, 2, Adams I teaches a method of sorting comprising providing a screen having a first and second planar array of wires (Fig. 34A-34E; col. 20, ln. 63-col. 21, ln. 23 teaching wire mesh of mesh 1, 2, 3—i.e., wire diameter of between 1/16 and 5/8<sup>th</sup> inches or Fig. 45E, F col. 25, ln. 30-66 teaching mesh range of between 2 and 32) and passing granular product through said screen for sorting (col. 1, ln. 35-40). Here, Adams I appears silent on the type of wire used and the tensile strength of said

wire in the specific embodiments cited above, but gives examples in other embodiments that uses a type of wire, 304 stainless steel, that can be produced with the desired tensile strength (col. 25, ln. 40-68). Thus, the feature of stainless steel with a specific tensile strength can be regarded as inherent.

Regarding claims 3-5, the claimed steps relate to a method of making the screen rather than the method of sorting. Examiner advises applicant that mixing statutory classes of invention may lead to indefiniteness during claim interpretation, thus Examiner seeks Applicant to clarify the record on the type of claim Applicant had wished to create. See MPEP 2173.05(p). Here, the method steps in claims 3-5 resemble product-by-process limitations and have been treated as such. That is, the limitations relating to how the screen is formed would not be expected to impart distinctive characteristics to the method of sorting and, moreover, when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct. Thus, claims 3-5 can be regarded as anticipated by the applied prior art, and the burden of proof is shifted to Applicant, not the Examiner, to show that the process of making renders the claims patentably distinct. See *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

Adams I as set forth above teaches all that is claimed. However, under an alternative interpretation, the wire mesh in Adams I may not be regarded as stainless steel possessing a tensile strength of at least 200,000 psi. Adams II, however, expressly teaches that it is well known to make the coarser screens (i.e., wire mesh

ranges of < 32) of stainless steel (col. 6, ln. 23-65). Further, Syte teaches that stainless steel wires with wire diameters in the 300 series, similar to those claimed, can be produced well above 200,000 psi (col. 4, ln. 64-col. 5, ln. 28; col. 9, 10 see table), thus it is implicit that 304 type stainless steel can be produced with a tensile strength at least 200,000 psi. Moreover, Syte teaches that this type of stainless steel wire possesses, in addition to enhanced tensile strength, improved torsional yields and bending limits (Id.). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Adams I to improve the screen's ability to withstand the vibrations and drilling fluids normally associated with shaker by using the stainless steel wire taught by Adams II and Syte.

### ***Conclusion***

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C Rodriguez whose telephone number is **703-308-8342**. The examiner can normally be reached on M-F during normal business hours (9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-872-9326** (After-Final **703-972-9327**).

The examiner's **UNOFFICIAL Personal fax number** is **703-746-3678**.

Further, the examiner is tentatively scheduled to move in April 2005 and the contact info at the new location will be as follows:

**April 2005, Personal telephone number is 571-272-6942**

**April 2005, UNOFFICIAL Personal fax number is 571-273-6942**

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see

**<http://pair-direct.uspto.gov>**

Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at 866-217-9197 (Toll Free).

Alternatively, inquiries of a general nature or relating to the status of this application or proceeding can also be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Signed by Examiner Joseph Rodriguez

jcr

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February 7, 2005

A handwritten signature in black ink, appearing to be 'JR' with a long, sweeping underline.